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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/953,154	10/17/1997	KEITH A. KOZAK	450.154US1	3463

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EXAMINER

VORTMAN, ANATOLY

ART UNIT

PAPER NUMBER

2835

DATE MAILED: 02/19/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/953,154

Applicant(s)

KOZAK ET AL.

Examiner

Anatoly Vortman

Art Unit

2835

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2002(Response to Restriction).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11,13-18 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) 22-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11,13-18,20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of claims 1-11, 13-18, 20, and 21 in Paper No. 22 is acknowledged. The traversal is on the ground(s) that "search and examination of all claims can be made without serious burden" and that "both the withdrawal of the final rejection and the Restriction Requirement are improper" in view that "no provision is made (in M.P.E.P.) for withdrawing a final rejection in order to issue a restriction requirement", but only "to either allow previously rejected claims, or to provide a new grounds of rejection".

The aforementioned arguments are found not persuasive because of the following:

Regarding the first point of arguments, the Examiner believes that adequate reasoning for restriction has been presented in the Election/Restriction requirement dated 06/12/01 (paper # 19).

Regarding the second point of arguments, the Examiner believes that Applicant's arguments are missing the point, since the following Office Action (i.e. following said Election/Restriction requirements) will present the new grounds of rejection, but in order to proceed with said new grounds of rejection, the Examiner believes that Election/Restriction requirement is appropriate.

Also, Examiner agrees that M.P.E.P. does not provide an explicit guidance regarding the withdrawal of finality only to issue Election/Restriction requirements, but at the same time the M.P.E.P. does not explicitly or implicitly prohibit doing so. Again, the Examiner would like to

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reiterate that withdrawal of finality has been made in order present new grounds of rejections, which will follow.

Also the Examiner would like to direct the Applicant's attention to the fact that the Applicant has responded to the Election/Restriction requirement (paper # 18), and in said response the Applicant did not argue the validity of the withdrawal of finality, but only requested that: "If [sic] Applicant's understanding of the claims to be included in Group I is incorrect, Applicant respectfully requests that the Restriction Requirement be withdrawn and a new Restriction Requirement be issued...", (paper # 18, lines 5+). Thus, the Examiner withdrew the previous Election/Restriction requirements (paper # 17) and issued new Election/Restriction requirements (paper # 19) as it was suggested by the Applicant. And, in conclusion, the Examiner would like to remind the Applicant that withdrawal of finality has been approved by Supervisory Patent Examiner, (please see the interview summary (paper # 20)).

Thus, in view of the preceding discussion, the requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-4, 13-18, 20, and 21, are rejected under 35 U.S.C. 102(e) as being anticipated by US/5,835,732 to Kikinis et al., (Kikinis).

Regarding claims 1 and 17, Kikinis disclosed (Fig. 1-6) a keyboard (Fig. 5) comprising: a housing (12); a plurality of keys disposed within the housing; a communication link (26') disposed within the housing (Fig. 6), wherein the communication link (26') is capable of communicating with a computer (66); and, a connector (14'') operatively coupled to the communication link (26'), said connector disposed within the housing and receptive to a corresponding connector (14) of a PDA device (10) such that the PDA device (10) communicates with the computer over the communication link (26'') when the connectors (14 and 14') are coupled, (column 4, lines 46+).

Regarding claim 20, Kikinis further disclosed that said PDA device (10) has a touch screen (16), (column 4, lines 56+).

Regarding claims 2-4, 18, and 21, Kikinis disclosed that the housing (12) has a plurality of surfaces (an end surface within the docking bay into which the connector (14') is disposed) defining a cradle cavity (i.e. a docking bay) shaped so that the device (10) fits into the cavity such that at least one surface (front surface) of the device (10) is exposed, (Fig. 5).

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Regarding claim 5, Kikinis disclosed that top and bottom surfaces of the device (10) are flush with the corresponding surfaces of the housing (12), (inherited in the structure, since the device (10) is inserted in a docking bay).

Regarding claims 6-8, and 13, Kikinis disclosed that the communication link may comprise serial cable or infrared (wireless) transceiver (column 1, lines 37+).

Regarding claims 9, 10, and 15, Kikinis disclosed a power source operatively coupled to the connector (14') of the keyboard to recharge a battery (15) of the device (10), (column 6, lines 3+).

Regarding claim 11, Kikinis disclosed that said device (10) is a personal digital assistant (PDA) operable in a docking mode or stand-alone mode (column 4, lines 46+; column 6, lines 3+).

Regarding claim 14, Kikinis disclosed that said device (10) has a touch screen (16) having at least one virtual key (column 4, lines 56+).

Regarding claim 16, Kikinis disclosed that said device (10) is a telephone handset, (column 14, lines 27+).

### ***Response to Arguments***

4. Applicant's arguments regarding the prior art rejections of claims 1-11, 13-18, 20, and 21 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

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5. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure:

US/5845282 disclosed PDA.

US/5625534, 5144567, 5583744, 4749364, and 5752857 disclosed various electronic devices attachable to computer keyboards.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anatoly Vortman whose telephone number is 703-308-7824.

The examiner can normally be reached on 9:30-6:00, Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Darren Schuberg can be reached on 703-308-4815. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3431 for regular communications and 703-305-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1782.

Anatoly Vortman  
Examiner  
Art Unit 2835

A.V.  
February 12, 2002

